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GRAYBEAL, JACKSON, HALEY LLP
155 - 108TH AVENUE NE
SUITE 350
BELLEVUE, WA 98004-5901

EXAMINER	
VAN DOREN, BETH	

ART UNIT	PAPER NUMBER
3623	

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/245,798	O'DONNELL ET AL.	
	Examiner	Art Unit	
	Beth Van Doren	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 July 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *120-132* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *120-132* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The following is a Final Office action in response to communications received 07/08/05. Claim 119 was canceled. Claims 120, 121, 126, and 128-132 have been amended. Claims 120-132 are pending in this application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 120-124, 126, 127, 129, and 131 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson et al. (U.S. 5,991,876).

3. As per claim 120, Johnson et al. teaches a clearinghouse server system method for receiving from publishers of works of authorship offers of licenses, presenting the offers to potential licensees, and acknowledging acceptances without intermediate human activity, comprising:

(a) presenting on a computer network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work, including fields for entry of default business rules and default prices to be used by the system for a plurality of works from a single publisher (See figures 5-6, column 3, lines 1-17 and 25-58, column 4, lines 55-67, table 4, column 8, lines 45-57, column 9, lines 55-67, and column 10, lines 17-40, wherein works are registered by a plurality of publishers to identify the work and terms of the work. See figure 6, column 3, lines 1-20, column 7, lines 40-55, column 8, lines 10-20 and 35-44, and column 10, lines 28-40, wherein fields allow the default rules and prices to be entered);

(b) receiving on the registration web pages from a first computer on the network information for a first default business rules and prices and a selection of the default rules and prices for a first work of authorship from a first publisher and storing on the server system a first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship (See figures 4-6, column 4, lines 55-67, table 4, column 8, lines 45-57, column 9, lines 55-67, and column 10, lines 17-40, wherein a network is used and a first registration record is recorded. See also the abstract, column 2, line 63-column 3, line 17, column 5, lines 12-30, column 7, lines 1-11 and 40-55, column 8, lines 10-20 and 35-44, wherein registration records are stored on the server system with the licensing terms. See column 7, lines 40-55, column 8, lines 10-20 and 35-44, and column 10, lines 28-40, wherein fields allow the default rules and prices to be entered);

(c) receiving on the registration web pages from a second computer on the network information for a second registration record for a second work of authorship from a second

publisher and storing on the server system a second registration record, the data stored in the second registration record specifying an identifier of the second work of authorship and all terms for offering to license the first work of authorship (See figures 4-6, column 4, lines 55-67, table 4, column 8, lines 45-57, column 9, lines 55-67, and column 10, lines 17-40, wherein a network is used and a second registration record is recorded. See also the abstract, column 2, line 63-column 3, line 17, column 5, lines 12-30, column 7, lines 1-11 and 40-55, column 8, lines 10-20 and 35-44, wherein registration records are stored on the server system with the licensing terms);

(d) receiving from a third computer on the network the identifier of the first work of authorship and, in response, presenting to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship which terms include the default rules and prices (See figures 2 and 7, column 4, lines 55-67, column 9, line 55-column 10, line 15 and lines 41-60, wherein an offer is presented to the user over the internet using the client/server architecture, the offer incorporating the defaults set); and

(e) receiving from the third computer on the network a message indicating acceptance of the offered terms and (f) responding to the third computer with a message that the acceptance has been received and acknowledged (See figures 2 and 7, column 3, lines 25-55, column 4, lines 55-67, column 9, line 35-column 10, line 15 and lines 41-60, wherein the third computer (the client) accepts the terms and the acceptance is acknowledged).

4. As per claim 121, Johnson et al. teaches a clearinghouse server system method for receiving from publishers of works of authorship offers of licenses, presenting the offers to potential licensees, and acknowledging acceptances without intermediate human activity, comprising:

(a) presenting on a computer network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work, including a reference to default license offering terms previously established in the server system for the publisher (See figures 5-6, column 3, lines 1-17 and 25-58, column 4, lines 55-67, table 4, column 8, lines 45-57, column 9, lines 55-67, and column 10, lines 17-40, wherein works are registered by a plurality of publishers to identify the work and terms of the work. See also figure 4, column 3, lines 1-20, column 5, lines 48-67, column 7, lines 12-22 and 34-55, column 8, lines 35-44, and column 9, lines 15-35, wherein the terms are linked and referenced to the registration record);

(b) receiving on the registration web pages from a first computer on the network information for a first registration record for a first work of authorship from a first publisher including a reference to default license offering terms previously established on the server system for the first publisher and storing on the server system a first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship which terms include the default rules and prices (See figures 4-6, column 4, lines 55-67, table 4, column 8, lines 45-57, column 9, lines 55-67, and column 10, lines 17-40, wherein a network is used and a first registration record is recorded. See also the abstract, column 2, line 63-column 3, line 17, column 5, lines 12-30, column 7, lines 1-11 and 40-55, column 8, lines 10-20 and 35-44, wherein registration records are stored on the server system with the licensing terms. See figures 4 and 6, column 3, lines 1-20, column 5, lines 48-67,

column 7, lines 12-22 and 34-55, column 8, lines 35-44, and column 9, lines 15-35, wherein the terms are linked and referenced to the registration record).

Johnson et al. further teaches elements (c)-(f). Elements (c)-(f) are substantially similar to claim 120, elements (c)-(f), and therefore are rejected using the same art and rationale set forth above in the rejection of claim 120.

5. As per claim 122, Johnson et al. teaches wherein the default license offering terms comprise prices that change based on publication date (See figure 7, column 1, lines 57-67, column 7, line 59-column 8, line 22, wherein the price changes based on the date).

6. As per claim 123, Johnson et al. teaches wherein the default license offering terms comprise prices that change based on date that the license is accepted (See figure 7, column 1, lines 57-67, column 7, line 59-column 8, line 22, wherein the price is based on when the license is accepted (i.e. how long after publishing)).

10. As per claims 124, Johnson et al. teaches wherein the prices decline over time (See figure 7, column 1, lines 57-67, column 7, line 59-column 8, line 22, wherein the price declines with time).

7. Johnson et al. teaches claim 126, elements (a) and (d). Claim 126, elements (a) and (d) are substantially similar to claim 120, elements (a) and (d), and therefore are rejected using the same art and rationale set forth above in the rejection of claim 120.

Johnson et al. further teaches:

(b) receiving on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second

publisher (See figures 4-6, column 2, line 63-column 3, line 17, column 4, lines 55-67, table 4, column 8, lines 45-57, column 9, lines 55-67, and column 10, lines 17-40, wherein a network is used and a first and second registration record are recorded);

(c) storing on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship (See the abstract, figure 4, column 2, line 63-column 3, line 17, column 5, lines 12-30, column 7, lines 1-11 and 40-55, column 8, lines 10-20 and 35-44, wherein registration records are stored on the server system with the licensing terms);

(e) receiving from the third computer on the network a message indicating acceptance of the offered terms and responding to the third computer with a message that the acceptance has been received and acknowledged, and sending to the third computer via the network an electronic copy of the work of authorship (See figures 2 and 7, column 3, lines 25-55, column 4, lines 55-67, column 9, line 35-column 10, line 15 and lines 41-60, wherein the third computer (the client) accepts the terms and the acceptance is acknowledged. See also figure 7, column 7, lines 1-10 and 40-55, column 9, lines 35-55, column 10, lines 40-60, wherein the third computer/client receives an electronic copy of the work for use).

8. As per claim 127, Johnson et al. teaches wherein the electronic copy includes electronically coded text (See figure 7, column 7, lines 1-10 and 40-55, column 9, lines 35-55, column 10, lines 40-60, wherein an electronic copy of written works, for example, would be electronically coded text).

9. Johnson et al. teaches claim 129, elements (a)-(e). Claim 126, elements (a)-(e) are substantially similar to claim 128, elements (a)-(e), and therefore are rejected using the same art and rationale set forth above in the rejection of claim 128.

Johnson et al. further teaches:

(f) storing a record of the accepted license and making the record available for look-up from any computer on the publicly accessible network (Column 3, lines 44-57, column 8, lines 1-20, column 9, links 35-67, wherein the record is stored and accessible in the system).

10. As per claim 131, Johnson et al. teaches wherein functions of the server system are distributed across a plurality of physical computers and at least one of the server system steps is performed in the first computer (See figure 2, abstract, column 3, lines 45-60, column 4, lines 45-67, column 9, line 55-column 10, line 15, wherein the function of the server system are distributed).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 125, 128, and 130 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (U.S. 5,991,876).

13. As per claim 125, Johnson et al. discloses wherein, before a registration record is stored on the server system, an operator of the computer that provides the information for the registration record must first enter a name which must match a name stored on the server system

(See figures 2 and 4-6, column 3, lines 1-17 and 25-58, column 8, lines 45-57, column 9, lines 55-67, and column 10, lines 17-40column 11, lines 10-25, wherein the user enters his/her user name). However, Johnson et al. does not expressly disclose entering a password.

Johnson et al. discloses a system by which users gain access to copyrighted material for licensing and use. Therefore, the material of the system is proprietary. Johnson et al. further discloses tables identifying the parties involved with the system. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to also store passwords associated with the recorded users of the system in order to increase the security of the network and the integrity of the works and data stored therein. Login names and passwords are well known and readily used in the art.

14. Johnson et al. teaches claim 128, elements (a)-(d). Claim 126, elements (a)-(d) are substantially similar to claim 126, elements (a)-(d), and therefore are rejected using the same art and rationale set forth above in the rejection of claim 126.

Johnson et al. further teaches:

(e) receiving from the third computer on the network a message indicating acceptance of the offered terms and responding to the third computer with a message that the acceptance has been received and acknowledged (See figures 2 and 7, column 3, lines 25-55, column 4, lines 55-67, column 9, line 35-column 10, line 15 and lines 41-60, wherein the third computer (the client) accepts the terms and the acceptance is acknowledged);

(f) after the message indicating acceptance is received, the clearinghouse server system processes the order for a copy of the work of authorship for printing on paper (See figure 7,

column 7, lines 40-55, column 8, lines 1-22, column 9, lines 35-55, column 10, lines 40-60, wherein the third computer/client request the order of paper copies be supplied).

However, Johnson et al. does not expressly disclose that the order is processed by sending a copy to a printer or delivering copies.

Johnson et al. discloses that an authorized user orders paper copies, via the clearinghouse system, wherein the order is processed. Johnson et al. further discloses storing information about the authorized user, such as the user's address. Examiner points out that an order option, as disclosed in column 10, line 55, is a request that copies (i.e. paper copies) be supplied. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to process the order for paper copies and supply the copies by sending the copy to the printer and delivering the printed copies in order to more efficiently manage rights by controlling access to the copies being made.

15. As per claim 130, Johnson et al. teaches wherein the step of presenting license offering registration web pages is performed by a server in the server system and the step of presenting to the third computer a licensing web page is performed by a server in the server system (See figure 2, abstract, column 3, lines 45-60, column 4, lines 45-67, column 9, line 55-column 10, line 15). However, while Johnson et al. discloses a network with client/server functionality and multiple computers, Johnson et al. does not expressly disclose multiple servers in this client/server network.

A server is merely a computer on a network that "serves" data to the rest of the network. Since Johnson et al. discloses a network with client/server functionality and multiple computers it would have been obvious to one of ordinary skill in the art at the time of the invention to

include multiple servers that share the functions of the network in order to increase the efficiency of the network by performing load balancing. See column 11, lines 19-25, wherein the design choices for the system are left up to the programmer, etc.

16. Claim 132 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (U.S. 5,991,876) in view of Digital Object Identifier (DOI) system. The following references disclose aspects of the DOI system:

i. Article "STM houses, CCC showcase latest DOI prototype via AAP" by Calvin Reid (referred to herein as reference A);

ii. Article "Metadata for the Millennium" by James Lichtenberg (referred to herein as reference B);

iii. Article "AAP unveils DOI as PSP Confab" by Calvin Reid (referred to herein as reference C);

iv. Article "Association of American Publishers proposes a digital object identifier (DOI) or electronic access to publications" from *Information Intelligence, Online Libraries, and Microcomputers* (referred to herein as reference D).

17. As per claim 132, Johnson et al. teaches publishing a work of authorship and allowing a user of the third computer to click on a hot spot that allows the user to obtain the rights to the work of authorship (See figure 7, column 2, lines 20-55, column 8, lines 5-22, and column 10, lines 40-60). However, Johnson et al. does not expressly disclose and the DOI system discloses that the work is published from a server on the network with the identifier of the first work embedded such that, when the first work of authorship is displayed on the third computer and a user of the third computer clicks on a hot spot in the work of authorship, the embedded identifier

is used to form a network address that links the third computer to the license offering web page for the first work of authorship (See at least reference A, page 1, section 2, reference B, page 2, sections 2-4, and reference C, page 1, sections 2-3, wherein the user encounters a digital work on the network and the user clicks of the DOI graphic, which links the user to a licensing page associated with the work).

Johnson et al. discloses a user viewing a published work and a network based server system that user accesses to link the user to the terms and rights of a license using hotspots in at least figure 7, column 2, lines 20-55, column 8, lines 5-22, column 9, lines 57-67, and column 10, lines 40-60. The DOI system discloses hotspots located directly in the work that the requesting user wishes to license, clicking on hotspots to link to licensing webpages, and using a presented licensing web page associated with the work to accept the offered license terms. Examiner points out that reference A discloses the DOI system used by the Copyright Clearance Center, who is the assignee of the Johnson et al. patent. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to integrate the hot spot into the published work enable the user to access the registration webpage and accept the terms in order to increase the ease of use of the system for the consumer by placing a link by which the user can automatically and efficiently accept the terms. See at least reference B, page 2, sections 1-4, and reference D, section 1, which discusses increasing the ease with which the consumer can identify the owner of a work of authorship and license said work.

Response to Arguments

18. Applicant's arguments with respect to Johnson et al. (U.S. 5,991,876) have been fully considered, but they are not persuasive. In the remarks, applicant argues that Johnson et al. does

not teach or suggest (1) the publisher specifying default rules and default prices for use with a plurality of works from a single publisher to make it easier for the publisher to enter relevant data for each work, (2) default license offering terms previously established in the server system, (3) sending to the prospective licensee's computer an electronic copy of the work of authorship, (4) automatically sending a copy of the work of authorship to a printer for printing and delivery to the licensee, (5) making a record available for lookup from any computer on the network.

In response to argument (1), Examiner respectfully disagrees. Examiner first points out that the limitations of claim 120 that concern default rules and prices recite presenting web pages "usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work" and receiving "a selection of the default rules and prices for a first work of authorship from a first publisher and storing [...] an identifier of the first work of authorship and all terms for offering to license the first work of authorship". Therefore, in the broadest reasonable interpretation, this limitations recite that a plurality of publishers utilize web pages to enter rules and prices for licensing each work of the publisher and that the default rules and prices for this first work of authorship are stored in the system. Johnson et al. discloses that for each work of authorship, a publisher (or other holder of the right) sets in the system default settings for the values of prices and rules associated with each work of authorship. These rules and prices are linked to the work via the database structure and they are assigned automatically by an operating system when a user requests licensing rights to the work. The defaults remain in effect unless canceled or overridden by the operator. See column 3, lines 1-17 and 25-58, column 7, lines 40-55, column 8, lines 10-20 and table 4, column 9, lines 55-67, and column 10, lines 17-40.

In response to argument (2), Examiner respectfully disagrees. Examiner points out the database structure of Johnson et al. divides works and rights. A first data file contains the works managed by the system and a second data file contains rights, each record in the rights table associated with one or multiple works in the works table. See column 2, line 63-column 3, line 20. Therefore, default rights set for work one would also by linked via the database structure to work two. Thus, Johnson et al. does teach and suggest the claim limitations as currently recited.

In response to argument (3), examiner respectfully disagrees. Johnson et al. teaches in figure 7, column 7, lines 40-55, column 9, lines 35-55, column 10, lines 40-60, wherein the third computer/client receives an electronic copy of the work for use. The customer queries the system to validate the customer's electronic rights and then utilizes the electronic copy.

In response to argument (4), this argument has been considered but is moot in view of the new grounds of rejection, established above, as necessitated by amendment.

In response to argument (5), Examiner respectfully disagrees. Examiner points out that the record being argued is in reference to claims 129, wherein the record is a record of an accepted license. See column 9, lines 35-65, and column 10, lines 40-60, which discuss querying the system to lookup the rights held by a potential licensee. This software discussed is operated on the computers of the system, which is implemented over a network such as the Internet. See column 3, lines 45-60.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beth Van Doren whose telephone number is (571) 272-6737. The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bvd
September 09, 2005

TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600